

## **REMARKS**

The following remarks are responsive to the Final Office Action mailed October 17, 2003. Applicant thanks the Examiner for the careful examination of this application.

Claims 1-6 and 9-12 have been amended to clarify the invention and to assist the Examiner in distinguishing the claims over the cited art of record. Support for these amendments can be found in at least Figures 1-8 and on pages 3 through 6. Applicant does not acquiesce to any of the subject matter of the claims prior to amendments, and reserves his right to pursue such subject matter in a continuation application.

### **Rejection Under 35 U.S.C. § 103(a) - Mathurin and Ishii**

The Examiner maintains his rejection of claims 1-6 and 9-12 over U.S. Patent No. 5,473,144 to Mathurin, Jr. ("Mathurin") and in view of U.S. Patent No. 5,768,389 to Ishii ("Ishii"). Applicant respectfully submits that claims 1-6 and 9-12 are not rendered unpatentable over Mathurin in view of Ishii under 35 U.S.C. § 103(a).

In order to meet this burden, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143; In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Neither Mathurin nor Ishii, individually or in combination, teach or suggest each and every limitation of the claims. Independent claims 1 and 12 recite a security system having a combination of elements including, *inter alia*, the element of "a portable chip card reader in a format of a PC card."

Mathurin fails to teach or suggest a portable chip card reader in the format of a PC card. Instead, Mathurin teaches a fixed reading apparatus 10 located on a table 28 for reading a card 12. (Mathurin, FIG. 1, Col. 14, ll. 6-10). Furthermore, the reading apparatus 10 is not in the shape of a PC card. Ishii also fails to cure the deficiencies of Mathurin. Similar to Mathurin, Ishii teaches a fixed card reader such as certification issuing system 100 and writing mechanism 120. (Ishii, FIG. 1). This system and mechanism is also not in the shape of a PC card. Thus, even if Mathurin were combinable with Ishii, neither reference teaches or suggests the "portable chip card reader in a format of a PC card," as recited in claims 1 and 12.

Moreover, regarding independent claim 1, neither Mathurin nor Ishii, individually or in combination, teach that the fingerprint sensor module comprises an interface for a connection to a network. The Examiner admits that the fingerprint scanner 22 of Mathurin lacks an interface for a connection to a network. Since Ishii completely lacks a fingerprint sensor, even if Mathurin were combinable with Ishii, these reference cannot teach or suggest such an interface, as recited in claim 1.

Therefore, for at least the above reasons, claims 1-6 and 9-12 are allowable over Mathurin in view of Ishii. Given that claims 2-6 and 9-11 depend on claim 1, claims 2-6 and 9-11 are allowable over Mathurin in view of Ishii for at least the same reasons noted above.

### **Conclusion**

In view of the foregoing remarks, Applicant respectfully submits that claims 1-6 and 9-12 are allowable over the cited art of record and are in condition for allowance.

Applicant requests the Examiner to reconsider and withdraw the above rejection to the claims culminating in allowance of the claims.

If the Examiner believes a telephone conference would expedite the allowance of the claims, the Examiner is invited to contact Sang Hui Michael Kim at (650) 849-6680.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: March 17, 2004

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Linda Phillips